

Atty Dkt. No.: 10010186-3  
USSN: 10/798,982

## REMARKS

### Formal Matters

Claims 22-41 are pending.

Claims 22, 26, and 34 are amended. Support for the amendments can be found throughout the specification and claims as originally filed. Specifically, support is found at page 4, final ¶, and page 5, ¶ 2. These amendments are made solely for the purpose of expediting prosecution and advancing the case to issuance. No new matter has been added.

Applicants respectfully request reconsideration of the pending claims in view of these amendments and the remarks made below.

### Priority

This application's priority information is set forth in the Applicant Data Sheet (ADS), as filed with the instant application on March 11, 2004.

Pursuant to MPEP § 601.05<sup>1</sup>, recitation of priority information in an ADS is all that is necessary to assert priority. Accordingly, a priority claim has already been made. See below for further discussion regarding the adequacy of the current claim to priority in the present application.

### Specification

The specification is objected to because certain documents have allegedly been improperly incorporated by reference. Specifically, the Office asserts that the incorporation by reference set forth on page 14, last paragraph, is improper because it does not identify with any detail the subject matter that is incorporated. The Office cites *In re de Seversky* in support of this position. The Applicants respectfully traverse this rejection.

In the Applicants' response to the Office's 16 September 2004 Action, the Applicants pointed out that the cases cited by the Office were not applicable to the instant case, because unlike the cited cases the instant case contains an incorporation by reference assertion. The Applicants respectfully maintain that *In re de Seversky* does not apply. Specifically, the question

---

<sup>1</sup> MPEP § 601.05: "(5) *Domestic priority information*. This information includes the application number, the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. §§ 119(c), 120, 121, or 365(c). Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. §§ 119(e) or 120, and § 1.78(a)(2) or § 1.78(a)(4), and need not otherwise be made part of the specification."

Att. Dkt. No.: 10010186-3  
USSN: 10/798,982

addressed in *In re de Seversky* was whether a patent application had actually attempted to make any incorporation by reference, rather than whether a patent application identify with any specific detail the subject matter that is incorporated.<sup>2</sup> On page 14, last paragraph in the Applicants' disclosure is set forth the requisite incorporation by reference and therefore *In re de Seversky* does not apply. In response to this point of fact, the Office now asserts that attorney arguments do not constitute evidence.

In addition, a search of the PTO website pertaining to similar phraseology as used by the Applicants identifies thousands of issued patents all using similar language. This high number of issued patents using the similar phraseology as that used by Applicants is indicative of the usual PTO practice to allow applications using that language.

Applicants would, specifically, like to draw the Examiner's attention to two issued U.S. patents where almost the exact same phraseology is used to incorporate a multiplicity of cited references. US Patent No. 6,346,553 uses the phrase: "The above-referenced patents and publications are hereby incorporated by reference in their entirety." See the last sentence of Example 9. Additionally, US Patent No. 5,686,513 uses the phrase: "All patents and other publications are hereby incorporated by reference in their entirety." See Summary of Invention, last sentence before the Detailed Description. The Applicants see no material difference between these incorporation statements and the statement used by the Applicants on page 14, last sentence, wherein the application sets forth: "All patents and publications mentioned herein, both *supra* and *infra*, are hereby incorporated by reference."

The Applicants would, therefore, like to invite the Office to explain why the phraseology as used in the thousands of other issued patents, and the '533 and '513 patents specifically, constitute appropriate incorporations by reference and the Applicants' analogous statement of incorporation does not. In view of the foregoing discussion, the Applicants respectfully submit that the incorporations by reference in question meet the requirements of MPEP § 608.01(p) and respectfully request that this objection be withdrawn.

The Office also objects to the specification because it does not contain a claim for priority as an initial statement.

According to MPEP § 601.05, if there is a priority claim set forth in the Application Data

---

<sup>2</sup> In *In re de Seversky* (the case cited in *Advanced Display*) the Appellant attempted to incorporate by reference teachings of interest into an application from a grandparent application. However, the application in question was totally devoid of "incorporation-by-reference" language - a situation wholly different from the instant application.

Atty Dkt. No.: 10010186-3  
USSN: 10/798,982

Sheet (ADS) there is no longer a requirement for a priority claim to be recited in the specification. This is because providing this information in the ADS constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and § 1.78(a)(2) or § 1.78(a)(4), and need not otherwise be made part of the specification. Since this application's priority information is set forth in the ADS filed on March 11, 2004, the priority claim does not need to be made in the specification. A copy of the ADS has already been made of record.

The Applicants note that the Office contends that in order to be a continuation, both applications must be filed with the same specification and claims. The Applicants respectfully disagree with this contention. The MPEP § 201.07 states that for an application to constitute a continuation: "the applicant in the continuation application must include at least one inventor named in the prior nonprovisional application. The disclosure presented in the continuation must be the same as that of the original application; i.e., the continuation should not include anything which would constitute new matter if inserted in the original application. The continuation application must claim the benefit of the prior nonprovisional application under 35 U.S.C. 120 or 365(c)." This section makes no mention of a requirement that the claims be the exact same ones as filed in the parent application. Therefore, the Applicants respectfully request that the Office state where the law sets forth this requirement or withdraw the objection.

#### **Rejection under 35 U.S.C. § 102**

Claims 22-29, 31, 33-37, 39 and 41 are rejected under 35 U.S.C. § 102(b) as being anticipated by Meade (USPN 5,952,172). Specifically, the Office asserts that Meade discloses a hybridization method that anticipates the claimed method. The Applicants respectfully traverse the rejection.

According to the MPEP, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Additionally, the identical invention must be shown in as complete detail as is contained in the claim. See MPEP 2131.

The present invention as is directed to methods for detecting the binding of a probe with a target molecule. The basis of the invention as amended is that free metal ions can be used to "dope" a transition metal ligand-labeled probe that has previously bound to a target nucleic acid to form a complex that is conductive and capable of producing a detectable signal. In accordance with this, each of the rejected claims explicitly recites a free metal ion as a distinct element.

Atty Dkt. No.: 10010186-3  
USSN: 10/798,982

Meade's disclosure, on the other hand, is directed to methods of labeling nucleic acids with electron transfer agents to form transition metal ligand complexes. Meade discusses using these transition metal ligand complexes to generate a light signal. Metal ions that are complexed in a transition metal ion complex are not free metal ions and cannot be inserted between base pairs of a nucleic acid duplex. Accordingly, Meade fails to disclose, teach or fairly suggest any method or composition that employs free metal ions.

Accordingly, because Meade fails to disclose, teach or fairly suggest free metal ions, a key element of the amended claims, it cannot be used to anticipate the currently pending claims. The Applicants, therefore, respectfully request this rejection be withdrawn.

**Rejection under 35 U.S.C. § 103**

Claims 31, 33, 39 and 41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Meade in view of Barany (6,027,889). Specifically, the Office asserts that Meade's hybridization methods, in combination with Barany's addressable arrays, render the claims obvious. The Applicants respectfully traverse this rejection.

As discussed above, Meade's disclosure is deficient in that it fails to teach the use of free metal ions, a required element of the rejected claims.

Barany's disclosure fails to meet Meade's deficiencies.

As such, Meade and Barany, taken alone or in combination, fail to teach or suggest at least two elements of the rejected claims.

Accordingly, Meade's hybridization methods in combination with Barany's addressable arrays, cannot render the claims obvious, and therefore Applicants respectfully request this rejection be withdrawn.

Atty Dkt. No.: 10010186-3  
USSN: 10/798,982

### CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone Tim Joyce at (650) 485-4310.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,

Date: 5-16-05

By: 

Bret Field  
Registration No. 37,620

Agilent Technologies, Inc.  
Legal Department, DL429  
Intellectual Property Administration  
P.O. Box 7599  
Loveland, Colorado 80537-0599

\\F:\DOCUMENTS\AGILENT\CON (10010186-3)\10010186-3 Response to OA dated February 18, 2005.doc